UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,331	07/19/2000	Hideto Horikoshi	JP9-1999-0035	1158

7590   03/08/2005

Anne Vachon Dougherty Esq
3173 Cedar Road
Yorktown Heights, NY 10598

EXAMINER
GURSHMAN, GRIGORY

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/619,331	HORIKOSHI ET AL.
		Examiner	Art Unit
		Grigory Gurshman	2132

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>2/22/2005</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>23 November 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   With regard to claims 1-6, 21 and 22, Applicant argues that Miller reference does

not anticipate each and every claim feature of the present invention. Regarding the

instant claims, Applicant points out a number of features of claimed invention, that are

different from Miller. With respect to this argument examiner states that none of the

alleged differences are reflected in the instant claims. All of the claimed features, in view

of broad but reasonable interpretation, are taught by Miller, as for example:

the limitation "storing setting data for establishing the computer settings with respect

to the attachment of the security device to the computer in ... a storage unit of the

computer" is met by a unique key code stored in the computer (see abstract and block

18 in Fig. 2). The limitation "detecting the attachment of the security device to the

computer" is met by comparing the code stored in the security key with the key code

stored in the computer (see abstract and block 84 in Fig. 5). The limitation "storing the

attachment data indicating the detection ... in a second storage unit ... in the computer"

is met by teaching that the key code received from the key 40 is compared to the key

code stored in the BIOS flash 24 instead of in main memory (see column 6, lines 5-7).

The limitation "detecting a removal of the security device from the computer based on

the setting data; and prohibiting access to the computer" is met by Fig.7. In Fig. 7 Miller

explicitly shows that operation system detects the removal of USB security key. Once

the removal is detected the computer is put out of operational mode (see block 380).

The limitation "connecting the connection device of an internal power wiring equipment"
is met by a hub (30 in Fig.2). The limitation "prohibiting access to the computer by the
disconnection" is met by Fig. 6. In Fig. 6, Miller explicitly shows disconnection causes
computer to go into a sleep mode (see unit 160).

2. In response to applicant's argument that the references fail to show certain features
of applicant's invention, it is noted that the features upon which applicant relies are not
recited in the rejected claim(s). Although the claims are interpreted in light of the
specification, limitations from the specification are not read into the claims. See *In re
Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. With respect to claims 7-20, Applicant argues that examiner has not established
prima facie case of obviousness since the cited references do not teach or suggest all
of the claim limitations. Examiner respectfully disagrees and points out that while Miller
teaches the key code stored in the computer, he does not teach the use of RFID tags
for the antenna coupled to the connecting device. This deficiency is compensated by
Isaacman, who teaches that a conventional RFID tag systems will now be described.
RFID tag systems generally consist of a personal computer (PC) or other computing
device, a radio frequency transmitter which sends an RF signal to the tag and which
"excites" the tag into generating an RF response, and a receiver which receives the
excited response from the tag (see column 3, lines 8-14). Examiner maintains that one
of ordinary skill in the art would have been motivated to modify a security device
attached to a computer by adding the RF antenna as taught in Isaacman for enabling

the system to rapidly identify the location of RFID tagged objects (see Isaacman,

abstract and Fig. 3.

4.   In view of the reason presented herein, the rejections of claims 1-22 are

maintained.

Drawings

5.   Formal drawings filed on 2/22/2005 are accepted by examiner.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1- 6, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated

by Miller (U.S. Patent No. 6.038.320).

8.   Referring to the instant claims, Miller discloses a computer security key (see

abstract). Miller teaches a computer security key provides security to a computer, which

includes a computer bus. The computer is programmed to function with the security key.

The security key includes a connector that is adapted to be coupled to the computer

bus, a controller coupled to the connector, and a storage device coupled to the

controller. The connector must be coupled to the computer bus for the computer to be

operational. In addition, a unique key code is stored in the security key and the computer. The key code stored in the security key must match the key code stored in the computer for the computer to be operational. Further, an encrypted password is stored in the security key. A password is entered into the computer and sent to the security key where it is encrypted by the security key. The encrypted password stored in the security key must match the encrypted password entered into the computer for the computer to be operational (see abstract and Fig. 2).

9.   Referring to the independent claims 1- 6, 21 and 22, the limitation "storing setting data for establishing the computer settings with respect to the attachment of the security device to the computer in ... a storage unit of the computer" is met by a unique key code stored in the computer (see abstract and block 18 in Fig. 2). The limitation "detecting the attachment of the security device to the computer" is met by comparing the code stored in the security key with the key code stored in the computer (see abstract and block 84 in Fig. 5). The limitation "storing the attachment data indicating the detection ... in a second storage unit ... in the computer" is met by teaching that the key code received from the key 40 is compared to the key code stored in the BIOS flash 24 instead of in main memory (see column 6, lines 5-7). The limitation "detecting a removal of the security device from the computer based on the setting data; and prohibiting access to the computer" is met by Fig.7. In Fig. 7 Miller explicitly shows that operation system detects the removal of USB security key. Once the removal is detected the computer is put out of operational mode (see block 380).

10.   Referring to claims 3 - 5, the limitation "connecting the connection device of an

internal power wiring equipment" is met by a hub (30 in Fig.2). The limitation

"prohibiting access to the computer by the disconnection" is met by Fig. 6. In Fig. 6,

Miller explicitly shows disconnection causes computer to go into a sleep mode (see unit

160). Referring to claims 5 and 6, it is inherent to store data while main power supply

of the computer is as at a halt and a backup power supply is operating.

11.   Referring to claim 2, Miller teaches the limitation "entering a predetermined

password" - see Fig. 8.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

13.   Claims 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Miller (U.S. Patent No. 6.038.320) in view of Isaacman (U.S. Patent No. 5.936.527).

14.   Referring to the instant claims Miller discloses a computer security key (see

abstract). Miller teaches a computer security key provides security to a computer, which

includes a computer bus. The computer is programmed to function with the security key.

The security key includes a connector that is adapted to be coupled to the computer

bus, a controller coupled to the connector, and a storage device coupled to the

controller. The connector must be coupled to the computer bus for the computer to be

operational. In addition, a unique key code is stored in the security key and the

computer. The key code stored in the security key must match the key code stored in

the computer for the computer to be operational (see abstract).

While Miller teaches the key code stored in the computer, he does not teach the use of

RFID tags for the antenna coupled to the connecting device.

15.   Referring to the instant claims, Isaacman discloses an apparatus for tracking

objects (see abstract). Isaacman teaches that a conventional RFID tag systems will

now be described. RFID tag systems generally consist of a personal computer (PC) or

other computing device, a radio frequency transmitter which sends an RF signal to the

tag and which "excites" the tag into generating an RF response, and a receiver which

receives the excited response from the tag (see column 3, lines 8-14). Isaacman shows

a PC connected to the Host Transceiver (i.e. RF antenna), which tracks the objects

according their RFID tags (see Fig. 3).

Therefore, at the time the invention was made, it would have been obvious to one of

ordinary skill in the art to modify a security device attached to a computer of Miller by

adding the RF antenna as taught in Isaacman. One of ordinary skill in the art would

have been motivated to modify a security device attached to a computer by adding the

RF antenna as taught in Isaacman for enabling the system rapidly identify the location

of RFID tagged objects (see Isaacman abstract and Fig.3)

16.   Referring to claims 13-19, Isaacman teaches analog to digital conversion.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Grigory Gurshman whose telephone number is

(571)272-3803. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barron can be reached on (571)272-3799. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.
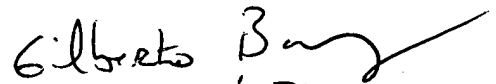
Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Grigory Gurshman
Examiner
Art Unit 2132

GG

GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100